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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,867	04/09/2004	Li-Tu Lin Wu	3215-74	9286

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EXAMINER

MULLER, BRYAN R

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,867

Applicant(s)

WU, LI-TU LIN

Examiner

Bryan R. Muller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. The first occurrence of the word " bodies' " in line 14 of page 1 of the specification should be replaced with " bodies ".
 - b. The word "has" in line 14 of page 1 of the specification should be replaced with " have ".
 - c. The word "at" should be added between the words "The" and "least" in line 11 of page 2 of the specification.Appropriate correction is required.

Claim Objections

2. Claim 2 is objected to because of the following informalities: The term "is" should be inserted between the words "layer" and "attached" in lines 13 and 15 of claims page 6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the adhesive layer of claim 1 and the inner adhesive layer of claim 2 can both be attached to the tool body. It is unclear if the applicant is claiming that there are two separate adhesive layers, one of which not being

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attached to the tool body or if the adhesive layer of claim 1 is the same layer as the inner adhesive layer of claim 2.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Craig (5,330,530).

6. Craig discloses a tool with colored patterns comprising a tool body (18) having a surface and at least one colored pattern (16) layer applied to the surface of the tool body and having an adhesive layer (abstract) to be attached to the surface of the tool body and a printed dye layer applied to the adhesive layer. Craig inherently provides a printed dye layer (the bands or strips must be colored by some sort of printed dye) that is attached to the adhesive layer.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arnold (4,836,059).

10. In reference to claim 1, Arnold discloses a tool with colored patterns comprising a tool body (10) having a surface and at least one colored pattern (col. 1, lines 51-53) layer applied to the surface of an elastomeric sleeve, that is attached to the tool body, and having an adhesive layer (col. 7, line 59-62) to be attached to the surface of the elastomeric sleeve and a printed dye (col. 7, line 55) layer (42) applied to the adhesive layer (the printed dye layer 42 is indirectly attached to the adhesive layer through layer 43). Although Arnold discloses adhesively bonding the label colored pattern to the elastomeric sleeve, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the label could be directly attached to the tool body, which would eliminate the need for the elastomeric sleeve, thus, minimizing parts and cost and the label would then be more permanently attached to the tool body.

11. In reference to claim 2, Arnold further discloses a composite layer (43; metalized polyester is a composite material) and at least one inner adhesive layer mounted between the corresponding at least one colored pattern layer and the surface of tool

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body, wherein the at least one inner adhesive layer is attached to the surface of the tool body and the at least one composite layer is attached to the at least one inner adhesive layer. If the applicant intends to claim two separate adhesive layers one of which attached to the printed dye layer and one side of the composite layer and the other, inner adhesive layer attached to the tool body and the opposite side of the composite layer, Arnold clearly discloses an inner adhesive layer that is attached to the tool body and the composite layer and it would have been obvious to one of ordinary skill in the art at the time the invention was made that there would be another adhesive layer attached to the printed dye layer and the other side of the composite layer because Arnold discloses that the label (40; includes 41, 42, 43 and the inner adhesive layer) is laminated (col. 3, line 23). The definition of laminated is ("Composed of layers bonded together" ¹) and it is commonly known that layers of laminates may be bonded together using adhesives, thus there would be an adhesive layer between each of the layers in the label including an adhesive layer attached to both the composite layer and the printed dye layer.

12. In reference to claims 3 and 4, Arnold further discloses a transparent film (41; protective laminate) applied to the colored pattern layer to keep the colored pattern layer from being damaged (col. 7, lines 49-50).

Claim Rejections - 35 USC § 103

¹ The American Heritage® Dictionary of the English Language, Fourth Edition
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13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Craig (5,330,230) in view of Freedman et al (6,165,576).

15. Craig discloses the tool with colored patterns, as discussed supra, but fails to disclose a composite layer and an inner adhesive layer mounted between the corresponding at least one colored pattern layer and the surface of tool body, wherein the inner adhesive layer is attached to the surface of the tool body and the composite layer is attached to the at least one inner adhesive layer. Freedman discloses an adhesive label comprising a core stiffening layer (16) made of a polyethylene blend (col. 4, line 16; a composite material) that is attached to an adhesive layer (18) that is used to attach the label to a substrate. Freedman further teaches that the stiffening layer provides adequate stiffness, which is necessary for proper printing, sheeting and cutting (col. 3, lines 37-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the colored pattern layer of Craig to a core stiffening (composite) layer that is attached to an adhesive layer to provide adequate stiffness for proper printing, sheeting and cutting. As taught by Freedman and further to attach the adhesive layer to the tool body of Craig.

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16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Craig (5,330,230) in view of Arnold (4,836,059).

17. Craig discloses the tool with colored patterns, as discussed supra, but fails to disclose a transparent film applied to the colored pattern layer to keep the colored pattern layer from being damaged. Arnold discloses a label for tools with a transparent film applied to a colored pattern layer to keep the colored pattern layer from being damaged, as discussed supra. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the colored pattern layer of Craig with a transparent film applied to a colored pattern layer to keep the colored pattern layer from being damaged, as taught by Arnold.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Craig (5,330,230) in view of Freedman et al (6,165,576) as applied to claim 2 and further in view of Arnold (4,836,059).

19. The obvious combination of Craig and Freedman discloses the tool with a colored pattern layer, inner adhesive layer and composite layer, as discussed supra, but fails to disclose a transparent film applied to the colored pattern layer to keep the colored pattern layer from being damaged. Arnold discloses a label for tools with a transparent film applied to a colored pattern layer to keep the colored pattern layer from being damaged, as discussed supra. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the colored pattern

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layer of Craig with a transparent film applied to a colored pattern layer to keep the colored pattern layer from being damaged, as taught by Arnold.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cirone (6,257,098) discloses a tool with colored pattern layers comprising adhesive layers and printed dye layers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan R. Muller whose telephone number is (571) 272-4489. The examiner can normally be reached on Monday thru Thursday and second Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/3/2005



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